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Colleen C. Lubking

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

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MILEF, ELDA G

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte COLLEEN C. LUBKING, JOHN N. HENNEBERGER,
FREDERICK JOEL MASON, JR., GEORGE W. PASLASKI, JR.,
SHARADA MUTHUSUBRAMANIAN, and BRIAN DONOHUE

Appeal 2010-012398
Application 09/882,304
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Colleen C. Lubking et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 7, 13, 14, 24, and 30-33. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

THE INVENTION

This invention is “methods and systems that offer different financial products depending on a customer’s determined life status.” Spec. para. [001].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for providing a financial product to a customer, said method comprising:

[A] receiving customer information from at least one source chosen from a purchase database, an application database, a call center database, an Internet database, and a public records database;

[B] analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification;

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Jun. 29, 2007) and Reply Brief (“Reply Br.,” filed Sep. 15, 2010), and the Examiner’s Answer (“Answer,” mailed Jul. 15, 2010).

[C] selecting, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product;

[D] monitoring, periodically, the customer information for changes;

[E] automatically revising, based on a change to the customer information, the customer's life status;

[F] selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product;

[F] determining the creditworthiness of the customer; and

[G] optimizing said first and second financial products based on said creditworthiness.

DISPOSTION OF APPEAL

The Examiner entered a new ground of rejection in the Examiner's Answer against claim 17 under 35 U.S.C. §112, second paragraph. Answer 2-7. The Examiner properly gave notice of the new ground of rejection (Answer 2-7) and the Technology Center Director approved it (Answer 19). As the Examiner indicated (Answer 18-19), the Appellants were required to respond to the new ground within two months in either of two ways: 1) reopen prosecution (*see* 37 CFR 41.39(a)(2)(b)(1)); or 2) maintain the appeal by filing a reply brief as set forth in 37 CFR 41.41 (*see* 37 CFR 41.39(a)(2)(b)(2)), “to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection.” In response, the Appellants filed a Reply Brief on September 15, 2010 in which the Appellants withdrew

the appeal as to claims 17 and 23. Reply Br. 3. Upon return of the application to the Examiner, the Examiner should (1) cancel claims 17 and 23 subject to the new ground of rejection and (2) notify the Appellants that the appeal as to claims 17 and 23 is dismissed and that claims 17 and 23 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1215.03, 8th ed., Rev. 7, Jul. 2008. Given that the appeal as to claims 17 and 23 stands dismissed, the rejections before us for review are reduced to those listed in the section that follows below.

Further, we note that claim 32 is dependent on claim 17, but that the Appellant did not withdraw the appeal as to claim 32. The Examiner should take appropriate action on claim 32.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Kunzle	US 2002/0023051 A1	Feb. 21, 2002
Moran	US 6,430,542 B1	Aug. 6, 2002

The following rejection is before us for review:

1. Claims 1, 7, 13, 14, 24, and 30-33 under 35 U.S.C. § 103(a) over Moran and Kunzle.²

² The Examiner entered the After Final Amendment filed on Jan. 27, 2007 in the Advisory Action of Feb. 7, 2007. In that Advisory Action, the Examiner also states that claims 1 and 24 are now rejected under 35 U.S.C. § 103(a) over the combination of Moran and Kunzle as was previously applied to claims 1, 5-7, and 13. Therefore, we assume that the reproduction of the pre-Advisory Action statement of the grounds of rejection (*see* Answer 12-

ISSUE

The issue is whether the Examiner erred in finding that claims 1, 7, 13, 14, 24, and 30-33 are unpatentable under 35 U.S.C. § 103(a) over Moran and Kunzle. Specifically, the issue is whether the Examiner erred in finding that the Moran teaches the steps marked C and F above.

ANALYSIS

The Appellants and the Examiner dispute whether Moran teaches the selecting steps of claim 1 marked C above. *See* App. Br. 7-10 and Answer 10. Step C requires selecting a financial product from a set of financial products based on recited criteria. In the rejection, the Examiner relies upon column 14, lines 35-42, and column 15, lines 9-20 of Moran as teaching this step. Answer 13. The Appellants argue (App. Br. 7-10), and we agree, that these cited portions of Moran describe selecting a financial plan as opposed to selecting a financial product. *See* Moran col. 14, ll. 35-42 and col. 15, ll. 9-20. Apparently, recognizing this, the Examiner cites column 1, lines 21-50 and Figure 49 of Moran (Answer 16), but these portions, while mentioning financial products, do not teach a step of selecting a financial product as specifically recited in step C. Therefore, we find that the

14) is an error and, that the grounds of rejection on review is the rejection of claims 1, 7, 13, 14, 24, and 30-33, rejected under 35 U.S.C. § 103(a) over Moran and Kunzle. *See* App. Br. 6, Reply Br. 3-4, and Answer 7.

Also, we assume that the new ground of rejection of claims 1, 7, 13-14, and 31 under 35 U.S.C. § 101, that appeared in the second Supplemental Examiner's Answer mailed on Dec. 9, 2008, has been withdrawn as; it no longer appears in the third Supplemental Examiner's Answer mailed on Jul. 15, 2010.

Examiner erred in finding that Moran taught step C. We note that the Examiner does not reply upon Kunzle to cure the deficiency of Moran.

Independent claim 24, while directed to an apparatus and not a method, recites similar limitations and was rejected by the Examiner using the same rationale. Accordingly, we reverse the rejection of claims 1, 7, 13, 14, 24, and 30-33 under 35 U.S.C. § 103(a) as being unpatentable over Moran and Kunzle.

DECISION

The decision of the Examiner to reject claims 1, 7, 13, 14, 24, and 30-33 is reversed.

REVERSED

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